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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,038	12/04/2001	Glenn R. Bowers	60116P1	2458

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SYNGENTA BIOTECHNOLOGY, INC.  
PATENT DEPARTMENT  
3054 CORNWALLIS ROAD  
P.O. BOX 12257  
RESEARCH TRIANGLE PARK, NC 27709-2257

EXAMINER

KUBELIK, ANNE R

ART UNIT PAPER NUMBER

1638

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/007,038

Applicant(s)

BOWERS ET AL.

Examiner

Anne R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14, 16, 17, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14, 16-17 and 36-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-8, 14, 16-17 and 36-37 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Response to Amendment***

3. The objection to claims 1-2, 15, 27 and 32 for the inclusion of a blank line where the ATCC Accession number should be is WITHDRAWN in light of amendment or cancellation of the claims.
4. The objection to claims 5-14, 16-20, 23-24, 30-31, 33 and 35 because informalities is WITHDRAWN in light of amendment or cancellation of the claims.
5. The rejection of claims 7-13 and 21-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is WITHDRAWN in light of cancellation of the claims.

***Claim Rejections - 35 USC § 112***

6. Claims 1-8, 14, 16-17 and 36-37 are rejected under 35 USC 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The rejection is repeated for the reasons of record as set forth in the Office action mailed 10 April 2003, as applied to claims 1-35. Applicant's arguments filed 11 August 2003 have been fully considered but they are not persuasive.

Applicant urges that the claims have been amended to recite an ATCC number (response pg 5).

This is not found persuasive because there is no affidavit or declaration by the Applicant, or a statement by an attorney of record over his or her signature and registration number, stating that the seeds will be irrevocably and without restriction or condition released to the public upon the issuance of a patent would satisfy the deposit requirement made herein.

7. Claims 16 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections. The rejection is modified from the rejection set forth in the Office action mailed 10 April 2003, as applied to claims 1-35, due to amendment of the claims. Applicant's arguments filed 11 August 2003 have been fully considered but they are not persuasive.

Applicant urges that the claims have been amended to address the rejections (response pg 5-6).

This is not found persuasive because the following rejection is new, due to amendment:

Claim 16 is indefinite because the members of the Markush group are not cells, but rather are organ types or plant parts, and hence do not further define "cells". It is suggested that --are

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from a plant part-- be inserted after "culture" in line 2. Additionally, all the plant parts in the Markush group should either be made plural, or an article should be inserted before each part.

Claim 36 lacks antecedent basis for the limitation "said progeny seed" in line 5.

***Claim Rejections - 35 USC § 102 - 35 USC § 103***

8. Claims 1-8, 14, 16-17 and 36-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Rhodes (1999, US Patent 5,942,666). The rejection is repeated for the reasons of record as set forth in the Office action mailed 10 April 2003, as applied to claims 1-35. Applicant's arguments filed 11 August 2003 have been fully considered but they are not persuasive.

Applicant urges that '666 does not disclose all of the elements of the subject matter of the claims. Applicant urges that instant S52-U3 is resistant to soybean cyst nematode (SCN) races 3, 9 and 14, while 9392379521283 is resistant to races 3 and 14 only, and S52-U3 has an earlier maturity than 9392379521283. Applicant thus urges that '666 is not 102(b) art (response pg 6).

This is not found persuasive. The rejection is made because the Examiner cannot determine whether the prior art possesses the unrecited characteristics. The Examiner does not have sufficient facts to determine whether the soybean plants and seeds are inherently the same. In addition, the Examiner cannot conclude that the claimed subject matter would have been obvious since it cannot be determined whether the soybean plants differ. Where the prior art product seems to be identical, except that the prior art is silent to a characteristic or property claimed, then the burden shifts to Applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention. See *In re Best* 195 USPQ 430, 433 (CCPA

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1977). In the instant case, Examiner does not have sufficient facts to know whether 9392379521283 is resistant or susceptible to SCN race 9. As to maturity, Tables 1 and 2 of '666 recite maturity in terms of days to maturity after September 1, giving days that correspond to October 12 (Table 1) and October 5 (Table 2). The Table on pg 17 of the instant specification lists the maturity date of S52-U3 as October 6, which is indistinguishable from the range given for 9392379521283. Furthermore, days to maturity is a trait affect by environment; as the two plant varieties were not compared to the same soybean variety, Examiner does not have sufficient facts to know if S52-U3 and 9392379521283, when grown side-by-side, would have the same maturity date.

Applicant urges that a *prima facie* case of obviousness was not made, *i.e.*, no suggestion or motivation to modify the reference was made, there was no reasonable expectation of success, and the reference does not teach or suggest all the claim limitations. Applicant urges that '666 does not teach or suggest a soybean cultivar that is resistant to SCN races 3, 9 and 14 nor does it teach or suggest the relatively early cultivar S52-U3 (response pg 6-7).

This is not found persuasive for the reasons indicated above. Furthermore, Applicant argues that the rejection does not present a *prima facie* case of obviousness under 35 U.S.C. 103 meeting the three criteria recited above. The Examiner maintains that a rejection under 35 U.S.C. 102 or 103 does not require the same analysis. The rejection is made because the Examiner cannot determine whether the prior art possesses the unrecited characteristics. The Examiner does not have sufficient facts to determine whether the soybean plants and seeds are inherently the same. In addition, the Examiner cannot conclude that the claimed subject matter would have been obvious since it cannot be determined whether the soybean plants differ.

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Where the prior art product seems to be identical, except that the prior art is silent to a characteristic or property claimed, then the burden shifts to Applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention. See *In re Best* 195 USPQ 430, 433 (CCPA 1977).

9. Claims 1-8, 14, 16-17 and 36-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Luzzi (2000, US Patent 6,084,159).

The rejection is repeated for the reasons of record as set forth in the Office action mailed 10 April 2003, as applied to claims 1-35. Applicant's arguments filed 11 August 2003 have been fully considered but they are not persuasive.

Applicant urges that '159 does not disclose all of the elements of the subject matter of the claims. Applicant urges that instant S52-U3 is resistant to soybean cyst nematode (SCN) races 3, 9 and 14, while 9524889614923 is not resistant to any races, and S52-U3 has an earlier maturity than 9524889614923. Applicant thus urges that '159 is not 102(b) art (response pg 6).

This is not found persuasive. The rejection is made because the Examiner cannot determine whether the prior art possesses the unrecited characteristics. The Examiner does not have sufficient facts to determine whether the soybean plants and seeds are inherently the same. In addition, the Examiner cannot conclude that the claimed subject matter would have been obvious since it cannot be determined whether the soybean plants differ. Where the prior art product seems to be identical, except that the prior art is silent to a characteristic or property claimed, then the burden shifts to Applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention. See *In re Best* 195 USPQ 430, 433 (CCPA 1977). In the instant case, Examiner does not have sufficient facts to know whether

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9524889614923 is resistant or susceptible to SCN races 3, 9 and 14. As to maturity, Table 1 of '159 recites maturity in terms of days to maturity after September 1, giving a day that corresponds to October 11. The Table on pg 17 of the instant specification lists the maturity date of S52-U3 as October 6. Days to maturity is a trait affected by environment; as the two plants were not compared to the same soybean variety, Examiner does not have sufficient facts to know if S52-U3 and 9524889614923, when grown side-by-side, would have the same maturity date.

Applicant urges that a *prima facie* case of obviousness was not made, *i.e.*, no suggestion or motivation to modify the reference was made, there was no reasonable expectation of success, and the reference does not teach or suggest all the claim limitations. Applicant urges that '159 does not teach or suggest a soybean cultivar that is resistant to SCN races 3, 9 and 14 nor does it teach or suggest the relatively early cultivar S52-U3 (response pg 6-7).

This is not found persuasive for the reasons indicated above. Furthermore, Applicant argues that the rejection does not present a *prima facie* case of obviousness under 35 U.S.C. 103 meeting the three criteria recited above. The Examiner maintains that a rejection under 35 U.S.C. 102 or 103 does not require the same analysis. The rejection is made because the Examiner cannot determine whether the prior art possesses the unrecited characteristics. The Examiner does not have sufficient facts to determine whether the soybean plants and seeds are inherently the same. In addition, the Examiner cannot conclude that the claimed subject matter would have been obvious since it cannot be determined whether the soybean plants differ. Where the prior art product seems to be identical, except that the prior art is silent to a characteristic or property claimed, then the burden shifts to Applicant to provide evidence that



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the prior art would neither anticipate nor render obvious the claimed invention. See *In re Best* 195 USPQ 430, 433 (CCPA 1977).

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst, Kimberly Davis, at (703) 305-3015.

Anne R. Kubelik, Ph.D.  
October 1, 2003



AMY J. NELSON, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600